

REMARKS

I. Introduction

The undersigned thanks Examiner Sweet for his review and consideration of the present Application, including for the time spent discussing the application in a telephone interview on July 14, 2009.¹ In response to the Non-Final Office Action mailed May 21, 2009, the undersigned submits the following amendment and remarks. Upon entry of the amendment, claims 1, 3-11, 13-14, 16, 20-25, and 32-37 are pending in the application. The present amendment amends claims 1, 23, and 35. Claims 2, 15, and 26-30 remain cancelled, and claims 12, 17-19, and 31 remain withdrawn. No new matter has been added by the present amendment. Support for the present amendments may be found, among other places, at paragraph 0010 and Figures 1-14 of the specification.

The present response is believed to overcome all of the prior Office Action rejections, and allowance of the pending claims is kindly requested.

II. Rejection of Claims 1, 3-11, 13-14, 16, 20-25, and 32-37

The Office Action rejects claims 1, 3-11, 13-14, 16, 20-25, and 32-37 under 35 U.S.C. 103(a) as unpatentable over U.S. Patent No. 6,454,809 to Tornier ("Tornier") in view of U.S. Patent No. 3,787,132 to Garnett ("Garnett"). The undersigned traverses this rejection, as the undersigned respectfully submits that there is no motivation to combine these two references

¹ Interview Summary: During the July 14, 2009 telephone interview, representatives of applicants, the undersigned, and the Examiner discussed the cited references and proposed claim amendments.

and, in any event, the combination of Tornier and Garnett does not result in the invention as claimed.²

Regardless, in an effort to move this application toward allowance, the undersigned respectfully submits that currently amended claims 1, 3-11, 13-14, 16, 20-25, and 32-37 are patentable over Tornier in view of Garnett.

A. Amended Claims 1, 3-11, 13-14, 16, 20-25, and 32-34

Amended independent claims 1 and 23 both require a prosthetic component, a fixing member, and a screw that passes through the fixing member to (1) secure the fixing member to the prosthetic component, where the screw is oriented (2) to secure purchase of the screw to a bone in which the prosthetic component is implanted, (3) wherein disposition of the screw in the fixing member causes securing of the fixing member to the prosthetic

² The Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex*, Federal Register, Vol. 72, No. 195, p. 57527 (October 10, 2007) explain what is required where an obviousness rejection is made:

As reiterated by the Supreme Court in *KSR*, the framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deer Co.* Obviousness is a question of law based on underlying factual inquiries. The factual inquiries enunciated by the Court are as follows:

- (1) Determining the scope and content of the prior art;
- (2) Ascertaining the difference between the claimed invention and the prior art;

and

- (3) Resolving the level of ordinary skill in the pertinent art.

Objective evidence relevant to the issue of obviousness must be evaluated by Office personnel. . . .

Office personnel fulfill the critical role of fact finder when resolving the *Graham* inquiries. . . . Office personnel must therefore ensure that the written record includes findings of fact concerning the state of the art and the teachings of the references applied.

. . .

Once the findings of fact are articulated, Office personnel must provide an explanation to support an obviousness rejection under 35 U.S.C 103.

The undersigned respectfully submits that the May 21, 2009 Office Action does not fulfill these requirements.

component to occur whether or not the screw gains purchase in the bone, and (4) wherein the fixing member is configured to connect rotatably to the prosthetic component.

In contrast to independent claims 1 and 23, Tornier shows an acetabular cup that has grooves 14 to allow the fixing of independent elements (such as independent element 29 shown in Figure 3d) to the cup. Independent element includes holes 40 through which a fixing screw may attach to hip bone. (Tornier, col. 5, lines 19-32.) Not only does Tornier fail to disclose or suggest a fixing assembly having a screw that is oriented both to secure purchase of the screw to a bone and so that disposition of the screw in a fixing member causes securing of the fixing member to the cup to occur whether or not the screw gains purchase in the bone, Tornier also fails to disclose or suggest, among other things, a fixing member that is configured to connect rotatably to the cup, as required by amended claims 1 and 23.

Also contrary to independent claims 1 and 23, Garnett shows a clamping arrangement for securing an attachment to a body, where the clamping arrangement includes a split dovetail that can be flexed by rotating a bolt 28 to provide a clamping action. (Garnett, abstract.) As an initial matter, Garnett does not disclose or suggest a fixing assembly for use with a prosthetic component and thus does not disclose or suggest a screw for securing purchase in a bone. The Action fails to provide the requisite motivation to combine this reference with Tornier or any other reference of record. Because Garnett is not for use with orthopaedic implants at all, Garnett cannot disclose or suggest a fixing assembly having a screw that is oriented to secure purchase of the screw to a bone and wherein disposition of

the screw in a fixing member causes securing of the fixing member to a prosthetic component to occur whether or not the screw gains purchase in the bone, as required by pending claims 1 and 23. Among other things, Garnett also fails to disclose or suggest a fixing member that is configured to connect rotatably to a prosthetic component. Thus, Garnett, alone or in combination with Tornier or any other reference of record, fails to disclose or suggest the fixing assembly of claims 1 and 23.

Claims 3-11, 13-14, 16, 20-22, and 32-34 depend from claim 1 and are therefore patentable for the same reasons claim 1 is patentable, and may be patentable for additional reasons. Claims 24-25 depend from claim 23 and are therefore patentable for the same reasons claim 23 is patentable, and may be patentable for additional reasons.

B. Amended Claims 35-37

Amended independent claim 35 requires an acetabular cup having either one of a female location feature or a male location feature, a fixing member having the other of the female location feature or male location feature, and a screw that passes through the fixing member to (1) secure the fixing member to the acetabular cup, where the screw is oriented (2) to secure purchase of the screw to a bone in which the acetabular cup is implanted, (3) wherein disposition of the screw in the fixing member causes securing of the fixing member to the acetabular cup to occur whether or not the screw gains purchase in the bone, and (4) wherein the screw is not located in either the male or female location feature.

In contrast to independent claim 35 and as detailed above, Tornier shows an acetabular cup that has grooves 14 to allow the fixing of independent elements (such as

independent element 29 shown in Figure 3d) to the cup. Among other things, Tornier fails to disclose or suggest a fixing assembly having a screw that is oriented both to secure purchase of the screw to a bone and so that disposition of the screw in a fixing member causes securing of the fixing member to the cup to occur whether or not the screw gains purchase in the bone, as required by pending claim 35.

Also contrary to independent claim 35, Garnett shows a clamping arrangement that includes a split dovetail and a bolt 28 that is contained completely within the dovetail extension 15. As mentioned above, Garnett does not disclose or suggest a fixing assembly for use with an acetabular cup and thus does not disclose or suggest a screw for securing purchase in a bone. Because Garnett is not for use with orthopaedic implants at all, Garnett cannot disclose or suggest a fixing assembly having a screw that is oriented to secure purchase of the screw to a bone and wherein disposition of the screw in a fixing member causes securing of the fixing member to an acetabular cup to occur whether or not the screw gains purchase in the bone, as required by amended claim 35. Moreover, among other things, Garnett also fails to disclose or suggest a fixing assembly where the screw is not located in either male or female location features that comprise part of the fixing assembly.

In fact, Garnett teaches away from the claimed invention, for bolt 28 is contained completely within the dovetail extension of Garnett. Because the dovetail of Garnett must be large enough to accommodate the bolt contained therein, the dovetail mechanism disclosed by Garnett would not be suitable for use with all acetabular cups, which in some instances

are relatively small. Thus, Garnett, alone or in combination with Tornier or any other reference of record, fails to disclose or suggest the fixing assembly of claim 35.

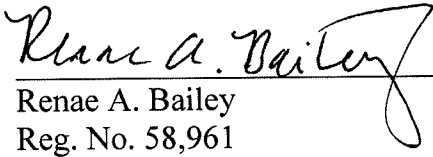
Claims 36-37 depend from claim 35 and are therefore patentable for the same reasons claim 35 is patentable, and may be patentable for additional reasons.

Accordingly, both Tornier and Garnett, as well as all other art of record, individually or in combination, fail to disclose or suggest the fixing assembly as presently claimed. In view of the foregoing, allowance of claims 1, 3-11, 13-14, 16, 20-25, and 32-37 is respectfully requested.

CONCLUSION

The undersigned respectfully submits that all pending claims are in a condition for allowance. Any fees due at this time may be charged to Deposit Account number 11-0855. If there are any matters that can be addressed by telephone, the Examiner is urged to contact the undersigned attorney at 404.532.6947.

Respectfully submitted,


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